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Filing date: **08/28/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046058
Party	Defendant Medtronic, Inc. Medtronic, Inc. 710 Medtronic Parkway Minneapolis, MN 554325604
Correspondence Address	Dean R. Karau Fredrikson & Byron, P.A. 200 South Sixth Street Suite 4000 Minneapolis, MN 554021425 UNITED STATES ip@fredlaw.com, dkarau@fredlaw.com
Submission	Answer and Counterclaim
Filer's Name	Dean R. Karau
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Signature	/Dean R. Karau/
Date	08/28/2006
Attachments	MAXIMO.pdf ( 7 pages )(458739 bytes )

Registration Subject to Cancellation

Registration No	2834864	Registration date	04/20/2004
Registrant	Masimo Corporation 2852 Kelvin Avenue Irvine, CA 926145826 UNITED STATES		
Goods/Services Subject to Cancellation	Class 010. First Use: 2001/07/00 , First Use In Commerce: 2001/07/00 Goods/Services: Medical apparatus comprised of computer software, computer hardware and in vivo sensors for medical use, namely, for blood constituent monitoring, electrical activity monitoring, and hemodynamic monitoring		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Masimo Corporation,	)	
	)	Cancellation No. 92,046,058
	)	Registration No. 2,916,730
Petitioner,	)	Mark: MAXIMO
v.	)	
	)	
Medtronic, Inc.,	)	
	)	
Registrant,	)	
	)	
and	)	
	)	
Medtronic, Inc.	)	
	)	
Counterclaim Petitioner,	)	
v.	)	
	)	
Masimo Corporation,	)	
	)	
Counterclaim Registrant	)	
	)	
	)	
Commissioner for Trademarks	)	
P.O. Box 1451	)	
Alexandria, VA 22313-1451	)	

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**ANSWER TO PETITION TO CANCEL (MAXIMO)**  
**AND COUNTERCLAIM PETITION TO CANCEL**

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**ANSWER**

Registrant, Medtronic, Inc., for its answer to the Petition to Cancel filed by Petitioner, Masimo Corporation, states and alleges as follows:

1. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Petition to Cancel and therefore

denies same.

2. Registrant admits that its website has included news releases containing limited information about Medtronic Emergency Response Systems, Inc.'s licensed use of Petitioner's products, and Registrant denies the remaining allegations contained in Paragraph 2 of the Petition to Cancel.

3. Registrant admits that its website has included news releases containing limited information about Medtronic Emergency Response Systems, Inc.'s licensed use of Petitioner's products and its licensed use of the products of others, and Registrant denies the remaining allegations contained in Paragraph 3 of the Petition to Cancel.

4. Registrant denies the allegations contained in Paragraph 4 of the Petition to Cancel.

5. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in Paragraph 5 of the Petition to Cancel, that Petitioner is the owner of U.S. Registration No. 2,834,864 for the mark ACCURATE MONITORING WHEN YOU NEED IT MOST, and therefore denies same; Registrant admits that it has adopted and uses the slogan "confidence where it's needed most" in connection with its MAXIMO mark; and Registrant denies the remaining allegations contained in Paragraph 5 of the Petition to Cancel.

6. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Petition to Cancel and therefore denies same.

7. Registrant is without knowledge or information sufficient to form a belief as to

the truth of the allegations contained in Paragraph 7 of the Petition to Cancel and therefore denies same.

8. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 8 of the Petition to Cancel and therefore denies same.

9. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the Petition to Cancel and therefore denies same.

10. Registrant denies the allegations contained in Paragraph 10 of the Petition to Cancel.

11. Registrant denies the allegations contained in Paragraph 11 of the Petition to Cancel.

12. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 12 of the Petition to Cancel and therefore denies same.

13. Registrant denies the allegations contained in Paragraph 13 of the Petition to Cancel.

14. Registrant denies the allegations contained in Paragraph 14 of the Petition to Cancel.

15. Registrant denies the allegations contained in Paragraph 15 of the Petition to Cancel.

16. Registrant admits that it has no license, consent or permission to use or register

the MAXIMO mark, and Registrant states that it does not need license, consent or permission to use or register the MAXIMO mark, and Registrant denies the remaining allegations contained in Paragraph 16 of the Petition to Cancel.

17. Registrant denies the allegations contained in Paragraph 17 of the Petition to Cancel.

18. Except as expressly admitted or otherwise answered, Registrant denies each and every allegation contained in the Petition to Cancel.

### **SEPARATE DEFENSES**

1. The Petition to Cancel fails to state a claim for which relief may be granted.
2. Petitioner's claims are barred by the doctrines of laches, estoppel and acquiescence.
3. Petitioner's claims are barred by the doctrine of unclean hands.

### **COUNTERCLAIM**

Counterclaim Petitioner, Medtronic, Inc., a Minnesota corporation with its principle place of business at 710 Medtronic Parkway, Minneapolis, Minnesota 55432-5604, believes that it is or will be damaged by Registration No. 2,834,864, and hereby petitions to cancel the same. The grounds for cancellation are as follows:

1. Counterclaim Petitioner is the world's leading medical technology company providing lifelong solutions for people with chronic disease. Medtronic offers one of the broadest, most complete lines of surgery products in the industry.
2. Counterclaim Petitioner uses variations on the term "confidence" in connection

with the promotion of its MAXIMO<sup>®</sup> and INSYNC MAXIMO<sup>®</sup> implantable cardioverter defibrillators, including the phrase “confidence where it ’s need most.”

3. Counterclaim Registrant has filed petitions to cancel Counterclaim Petitioner ’s registrations for MAXIMO and INSYNC MAXIMO, and in the petitions, alleges that Counterclaim Registrant owns U.S. Registration No. 2,834,864, for ACCURATE MONITORING WHEN YOU NEED IT MOST, and that Counterclaim Petitioner ’s use of the phrase “confidence where it ’s need most” exacerbates the likelihood of confusion as the result of Counterclaim Petitioner ’s use of its MAXIMO and INSYNC MAXIMO marks.

4. Continued registration of U.S. Registration No. 2,834,864, for ACCURATE MONITORING WHEN YOU NEED IT MOST is and/or will cause damage to Medtronic by, among other things, interfering with Medtronic’ s right to use the phrase “confidence where it ’s need most” in connection with its MAXIMO and INSYNC MAXIMO marks, as well as continued use and registration of its MAXIMO and INSYNC MAXIMO marks.

5. ACCURATE MONITORING WHEN YOU NEED IT MOST is merely a descriptive term when applied to and used in connection with the goods involved in the registration, and ACCURATE MONITORING WHEN YOU NEED IT MOST has not acquired secondary meaning or become distinctive of the goods identified in the involved registration.

6. Upon information and belief, the name of the current owner of Registration No. 2,178,565 is Masimo Corporation, a Delaware corporation, located at 40 Parker, Irvine, California, 92618.

7. If any other fees are required by this filing, they may be charged to deposit

account number 061910.

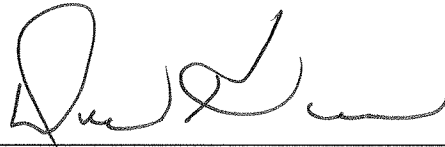
Please address all communication to Dean R. Karau, Fredrikson & Byron, P.A., Suite 4000, 200 South Sixth Street, Minneapolis, Minnesota, 55402-1425.

**WHEREFORE,**

1. Registrant respectfully requests that the Petitioner's Petition to Cancel be dismissed with prejudice; and

2. Counterclaim Petitioner believes that it will be damaged by U.S. Registration No. 2,834,864 and prays that it be cancelled.

Dated: August 18, 2006



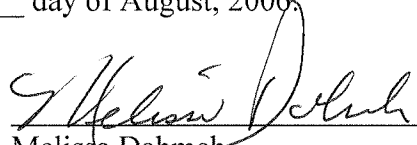
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**Attorneys for Registrant and  
Counterclaim Petitioner, Medtronic, Inc.**

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the ANSWER TO PETITION TO CANCEL (MAXIMO) AND COUNTERCLAIM PETITION TO CANCEL was served by United States mail on the attorney of record for Petitioner in this action, Deborah S. Shepherd, Knobbe, Martens, Olson & Bear, LLP, 2040 Main Street, 14th Floor, Irvine, CA 92614, by mailing it to her address of record by first class mail, postage prepaid, this 28<sup>th</sup> day of August, 2006.

  
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Melissa Dahmeh

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